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IN THE

Supreme Court of the United States

FESTO CORPORATION,
Petitioner,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD., A/K/A SMC CORPORATION AND SMC PNEUMATICS, INC.,
Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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BRIEF FOR AMICUS CURIAE IN SUPPORT OF NEITHER PARTY ON BEHALF OF THE PATENT, TRADEMARK, & COPYRIGHT SECTION OF THE BAR ASSOCIATION OF THE DISTRICT OF COLUMBIA

William P. Atkins
Pillsbury Winthrop, LLP
1600 Tysons Boulevard
McLean, Virginia 22102
(703) 905-2000

Attorney for *Amicus Curiae*

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STATEMENT OF AMICUS CURIAE

The Bar Association of the District of Columbia is a non-profit organization that has a Patent, Trademark, & Copyright Section which monitors intellectual property developments in both the law and practice. This section includes members of the bar who specialize in intellectual property law, with an emphasis on patent law. Members frequently represent patent applicants, patent owners, and accused patent infringers in various matters, and are concerned with the use and effect of prosecution history estoppel on claim interpretation in patent infringement.

Other than an interest in seeking consistent, precise, and well-founded interpretations of patent law, the Patent, Trademark & Copyright Section of the Bar Association of the District of Columbia supports neither party, and respectfully requests that this Court consider the arguments contained herein.[1]

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[1] None of the parties or their counsel has contributed either substantively or monetarily to the preparation of this brief. Only the Bar Association of the District of Columbia and its members have made a monetary contribution to the creation, preparation, and submission of this brief. Written consent to the filing of this brief has been granted by all parties and is filed herewith. Pursuant to Sup. Ct. R. 37.6, the author also acknowledges and appreciates the assistance of Daniel E. Yonan, Dale S. Lazar, Kevin T. Kramer, and Emily T. Bell.

SUMMARY OF ARGUMENT

If an applicant amends a patent claim by adding the term "red" to modify the term "wagon," for reasons relating to patentability, is the range of equivalents for wagons barred or just the range of equivalents for the color of the wagons? In other words, to what claim terms does prosecution history estoppel ("PHE") apply?

In the Stoll patent at issue in this case, the sealing rings were amended from sealing "means" to sealing "rings," both with modifying claim terms. Should PHE apply to the term "sealing rings," or just the term "rings" or to "sealing rings" and its modifying claim terms?

The *Festo* decision held that the doctrine of equivalents is completely barred on "limitations" which is then defined as merely" claim language."[2] Patent claim terms have been historically "elements" and "limitations." This lack of clarity, as to what claim terms should be subjected to PHE, has become the focus of litigants and, even the Federal Circuit, as courts attempt the difficult task of applying *Festo's* PHE analysis to various patent claim terms. The bright line objective of *Festo* has unfortunately created an entirely new battleground – which claim terms will be subjected to PHE and why.

This brief attempts to guide the Court in resolving this issue because clarification of the scope and extent of PHE will help the resolution of all doctrine of equivalents cases that are based upon PHE. At the very least, the consistent use of precise nomenclature will provide clarity as to the scope and extent of PHE so that, in turn, the scope and

[2] *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 569 (Fed. Cir. 2000) (en banc).

extent of equivalents and infringement under the doctrine of equivalents can more readily be evaluated.

ARGUMENT

The objective of this brief is to help the Court appreciate the inherent problems in the use of imprecise nomenclature for claim terms during an analysis of PHE. This *amicus* brief looks first to one of the "elements" found in one of the claims at issue and then, using the historical guidance of caselaw and statutes, attempts to provide a framework for the Court's consideration of the scope and extent of the application of PHE on patent claims.

1. The Patent Claims At Issue

The following table compares inventor Stoll's originally filed claims 1 and 4 with issued claim 1. The Federal Circuit determined that PHE applied to both the magnetizable sleeve and the sealing ring elements but the focus of the following comparison is the "sealing ring element" referred to in the *Festo* decision.[3]

[3] *Festo*, 234 F.3d at 587-91.

Original Claim 1	Issued Claim 1(Claim 13)
a piston which is slidable in said tubular part and which has sealing means at each end for siping [sic wiping] engagement with an internal surface of the tubular part and so as to form a seal for the pressure medium[4]	said piston further including plural guide ring means encircling said piston body and slidingly engaging said internal wall and first sealing rings located axially outside said guide rings for wiping said internal wall as said piston moves along said tube to thereby cause any impurities that may be present in said tube to be pushed along said tube so that said first annular magnets will be free of interference from said impurities[6]
Original Claim 4	
Wherein the sealing means of the piston comprise sealing rings and the piston is provided with sliding guide rings near the sealing rings.[5]	

The claim language "sealing rings" and the words following that term, in issued claim 1, can be parsed in many ways, but the pertinent terms include the following:

1. Sealing,
2. Rings,
3. Located axially outside said guide rings, and
4. For wiping said internal wall as said piston moves along said tube to thereby cause any impurities

[4] Originally filed claim 1 on page 11 of U.S. Patent Application No. 06/153,999, which matured into the Stoll patent.

[5] *Id.* at page 12.

[6] U.S. Patent No. 4,354,125.

that may be present in said tube to be pushed along said tube so that said first annular magnets will be free of interference from said impurities.

The first question in the *Festo* analysis is what was amended. The "sealing means" element in the originally filed claim 1 was a statutorily defined means-plus-function element under 35 U.S.C. § 112, sixth paragraph. Claims 1 and 4 from the original application were cancelled, however, and new claim 13 was submitted.

A review of the prosecution history reveals that three of the four terms were amended. The term "sealing" was not amended, but it was part of the change from "sealing means for . . ." to "sealing rings." The term "rings" was originally "means for . . .," and the *Festo* opinion speaks about the narrowing aspect of this term.[7] The term "located axially outside said guide rings" was newly added with the "guide rings" noted in original claim 4 as being "near the sealing rings." Finally, the genesis for the fourth term set forth above for cleaning impurities out of the tube, appears to be from the "wiping engagement" function in original claim 1. Thus, this language was also added to issued claim 1. Again, all of these claim terms were amended except "sealing."

With this in mind, does the PHE apply to "sealing rings" alone and not the claim term "sealing?" This is a subtle, but critical distinction because it determines the very foundation for both the doctrine of equivalents and any infringement analysis that follows. Consider the effect of having the doctrine of equivalents available for the term "sealing" but not for the term "rings." If "rings" had no

[7] *Festo*, 234 F.3d at 589 ("a claim amendment which replaces means-plus-function language with language reciting the corresponding structure narrows the scope of the claim"). "Rings" was also recited in original dependent claim 4.

equivalents, the accused infringer with one ring instead of two could forcefully argue that one is not equal to two and that a single ring can never be an equivalent of the claimed "rings."

2. *Festo* v. *Warner-Jenkinson* – PHE Differences

If an amendment was voluntary and related to patentability, as it was with *Warner-Jenkinson's* addition of a lower end range of 6.0 pH to its claim, it "would bar the application of the doctrine of equivalents as to that [amended] element."[8] In the *Festo* case, however, the Federal Circuit held that the application of the doctrine of equivalents is completely barred as to the amended claim limitation, where a limitation was defined only as "claim language."[9] The difference in terminology used by this Court and the Federal Circuit is symptomatic of the confusion regarding the proper scope and extent of PHE. Furthermore, this sweeping change of terminology by the Federal Circuit to patent claims only having "limitations" and not "elements" is problematic because there is a long and confused history of both terms.

Cases decided after the Federal Circuit's *Festo* decision provide ample evidence of the mischief caused by not precisely articulating what should be included in the scope and extent of the PHE, and what should not.

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[8] *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997) (emphasis added).

[9] *Festo*, 234 F.2d at 564 n.1. In the *Festo en banc* decision, the court decided that it is "preferable to use the term 'limitation' when referring to claim language and the term 'element' when referring to the accused device," but "because the en banc questions use the term 'element,'" the Federal Circuit used the term "element" instead of "limitation" in its decision.

3. Post-*Festo* Cases Evidence The Problem

Consider the Federal Circuit's own foray into this post-*Festo* area in the recent *Lockheed* case.[10] In the prosecution of the application that led to issuance of the patent-in-suit in *Lockheed*, the applicant twice amended claim terms in phrase "b" of the original application.

> The pertinent language of [originally filed] limitation [b] stated, 'means for rotating said wheel in accordance with a predetermined sinusoidal variation.' . . . the applicant amended limitation [b] to state, 'means for rotating said wheel in accordance with a predetermined *rate schedule which varies sinusoidally over the orbit.*' The applicant again amended the claim by adding the phrase 'at the orbital frequency of the satellite.'[11]

Applying PHE under the *Festo* "limitation" analysis, the Federal Circuit held that "prosecution history estoppel [bars] the application of the doctrine of equivalents' to limitation [b]."[12] The Federal Circuit determined that the "first amendment wholly replaced the phrase 'sinusoidal variation'" and therefore held that this "amendment illustrates that the entire limitation of limitation [b] was changed, not that a completely separate limitation, unrelated to sinusoidal variation, was added."[13] A more precise analysis could be that "sinusoidal variation" was a limitation

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[10] *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 249 F.3d 1314 (Fed. Cir. 2001)(en banc request denied).

[11] *Id.* at 1326 (note that the court adopted the use of the term limitation instead of element in accordance with the *Festo* decision) (quoting *Festo*, 234 F.3d at 586).

[12] *Id.* at 1327 (quoting *Festo*, 234 F.3d at 586).

[13] *Id.* at 1327.

modifying the means-plus-function element of "means for rotating said wheel" and then dealt with as a separate and distinct claim term. Alternatively, because it would be a "limitation" that modifies an "element," PHE applicable to it could affect the modified element. The "sinusoidal variation" could also be considered a separate element and therefore, PHE applicable to it does not affect the doctrine of equivalents analysis of the "means for rotating said wheel."

Further examples of courts wrestling with the application of PHE to claim terms after *Festo* include the *ACLARA* and *Creo* cases.[14] In *ACLARA*, one element was found to have three limitations, and the applicant did not amend the limitation at issue. It was decided that PHE could not apply to that unamended limitation.[15] Thus, the court took a more limited approach regarding the scope of PHE based on a more precise parsing of the claim terms. In *Creo*, the court stated that "[r]ather than woodenly applying *Festo*, the court will adopt the more nuanced approach" of *ACLARA*.[16] "Simply put, the issue in this [*Creo*] case is . . . whether the *Festo* bar covers implicit changes in a limitation."[17] This is the very issue that can be corrected with considered forethought.

4. What Is An "Element" And A "Limitation" – A History

An understanding of the historical treatment and terminology applied to claim terms may provide some guidance to the Court in considering the question raised by

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[14] *ACLARA Biosciences, Inc. v. Caliper Technologies Corp.*, 125 F. Supp. 2d 391 (N.D. Cal. 2000); *Creo Products Inc. v. Presstek, Inc.*, 2001 WL 637397 (D. Del. 2001).

[15] *ACLARA*, 125 F. Supp. 2d at 402.

[16] *Creo*, 2001 WL 637397, at *9.

[17] *Id.* at *8.

this brief and the facts of Festo. Throughout the history of patent law in the United States, this Court, the lower courts, and Congress have used the words "elements" and "limitations" to refer to terms in patent claims.

Our research has taken us from the Patent Act of 1790 to a line of post-*Festo* cases. Beginning in 1790, a patent was required to have merely a written description of the invention.[18] Three years later, the written description was required to include "full, clear and exact terms ... [to] enable any person skilled in the art ... to make, compound, and use the same."[19] In 1818, this Court introduced, but did not adopt, the term "elements."[20] In 1836, the law was amended to require that the written description of a patent include claims,[21] and those claims were composed of all the parts mentioned in the combination. These "parts"[22] of a

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[18] Patent Act, ch. 7, § 2, 1 Stat. 109-12 (1790) (a description that was so particular "as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art to manufacture" the invention).

[19] Patent Act, ch. 11, § 3, 1 Stat. 318-23 (1793).

[20] *Evans v. Eaton*, 16 U.S. (1 Wheat.) 454, 485 (1818) ("[t]he grant [of the patent] is not for the parts [of the invention], because it is for the whole; not in their rudiments or *elements* ... but for the peculiar properties, the new and useful practical results from each machine, and the vast improvements from their combination in this art") (emphasis added).

[21] Patent Act, ch. 357, § 6, 5 Stat. 117 (1836) ("[inventor must] particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery").

[22] *Silsby v. Foote*, 55 U.S. (1 How.) 218, 224 (1852); *Prouty v. Ruggles*, 41 U.S. (1 Pet.) 336, 341 (1842) ("this combination, composed of all the *parts* mentioned in the specification, and arranged with reference to each other, and to other *parts* of the plough, in the manner therein described is stated to be the improvement, and is the thing patented") (emphasis added); *Brookes v. Fiske*, 56 U.S. (1 How.) 211, 220 (1853) ("[t]o infringe, Norcross must use all the *parts* of Woodworth's combination") (emphasis added); *Eames v. Godfrey*, 68

claim were broad portions of the combinations.[23] In 1862, this Court referred to a distinct, specific part of a combination as an "element" and, if one "element" was surrendered, "the thing claimed disappears."[24] In 1870, the statutory claiming requirement was refined to require that an applicant "particularly point out and distinctly *claim* the part, improvement, or combination which he claimed as his invention or discovery."[25]

In 1879, this Court confirmed that a patent claim is comprised of "elements" or "parts."[26] The next year, this Court found that there were "necessary elements of the invention."[27]

Our research indicates that the first time the word "limitation" was applied to a patent claim term was by this Court in 1885. In that year, in the *Sargent* case, this Court

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U.S. (1 Wall.) 78, 79 (1864) ("that there is no infringement of a patent which claims mechanical powers in combination unless all the *parts* have been substantially used") (emphasis added); *Union Water-Meter Co. v. Desper*, 101 U.S. 332, 335-37 (1879) ("[i]t is a well-known doctrine of patent law, that the claim of a combination is not infringed if any of the material *parts* of the combination are omitted ... Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain *elements* or *parts*, we cannot declare that any one of these *elements* is immaterial. The patentee makes them all material by the restricted form of his claim") (emphasis added).

[23] *Union Water-Meter Co. v. Desper*, 101 U.S. 332 (1879).

[24] *Vance v. Campbell*, 66 U.S. (1 Black) 427, 429 (1862) ("[i]f one of the elements is given up, the thing claimed disappears").

[25] Patent Act, Ch. 230, § 26, 16 Stat. 198-217 (1870).

[26] *Union Water-Meter Co. v. Desper.*, 101 U.S. 332, 337 (1879) ("Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, we cannot declare that any one of these elements is immaterial").

[27] *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 224 (1880) ("[i]t is therefore essential to a correct determination of this case to consider what was the material, made by the patentee [sic] an element of his invention").

confirmed that patent claims included "elements" but, for the first time, opined on "limitations" within patent claims.[28] In 1894, this Court provided that a claim containing references to the elements included could not be broadened to include additional elements.[29]

The understanding that claims were comprised of "elements" was reinforced by the Patent Act of 1952, which stated in part, "an element in a claim for a combination may be expressed as a means or step for performing a specified function."[30] This statute allowed any element to be expressed in means-plus-function type language.

Contrary to the "element" claim term reference in the 1952 Patent Act, the 1965 Patent Act included the undefined word "limitations," and today the statute continues as 35 U.S.C. § 112, fourth paragraph which states in pertinent part: "A claim in dependent form shall be construed to incorporate by reference all the *limitations* of the claim to which it refers)".[31] The legislative history reveals only that the word "limitations" was added to the patent statute in the context of defining independent and dependent claims.[32] The 1975 Patent Act amended 35 U.S.C. § 112 yet again and included more language regarding limitations and involved multiple

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[28] *Sargent v. Hall Safe & Lock Co.*, 114 U.S. 63, 86-86 (1885).

[29] *See Wollensak v. Sargent*, 151 U.S. 221, 226-27 (1894) (a specific combination claim, containing letters or reference to the elements included, cannot be broadened to include additional elements).

[30] "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112 sixth paragraph.

[31] 35 U.S.C. § 112 paragraph 4 (emphasis added).

[32] Pub. L. No. 89-83, 79 Stat. 259 (1965).

dependent claims.[33] The addition of these two limitations-containing paragraphs to § 112 stand in stark contrast to paragraph 6 of the 1952 Act, which contains the element term discussed above.

In 1983, the Federal Circuit remarked that "[f]or a patent claim to have been anticipated under 35 U.S.C. § 102, all the *elements* in the claim … must have been disclosed in a single prior art reference or device."[34] In 1985, the Federal Circuit again emphasized "elements" in infringement analysis, providing that "[i]t is also well settled that each *element* of a claim is material and essential, and that in order for a court to find infringement, the plaintiff must show the presence of every *element* or its substantial equivalent in the accused device."[35] In 1987, the Federal Circuit again embraced elements as components of a device (either in the accused device or embodied by the invention).[36] That same year, however, the Federal Circuit also used "limitations"

[33] 35 U.S.C. § 112, third paragraph ("A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form"); 35 U.S.C. § 112, fourth paragraph ("Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further *limitation* of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the *limitations* of the claim to which is refers"); 35 U.S.C. § 112, fifth paragraph ("A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one previously set forth and then specify a further *limitation* of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the *limitations* of the particular claim in *relation to which it is being considered*") (emphasis added).

[34] *Radio Steel & Mfg. Co. v. MTD Prods., Inc.*, 731 F.2d 840, 845 (1984) (emphasis added).

[35] *Lemelson v. United States*, 752 F.2d 1538, 1551 (1985).

[36] *Perkin-Elmer Corp. v. Westinghouse Electric Corp.*, 822 F.2d 1528, 1533 n.9 (Fed. Cir. 1987) (emphasis added).

when referring to what was set forth in the claims.[37] And in 1999, the Federal Circuit opined that "an accused device that does not literally infringe a claim may still infringe under the doctrine of equivalents if each limitation of the claim is met in the accused device either literally or equivalently."[38]

The understanding that claims consist of elements is codified in 37 C.F.R. § 1.75(i), which states: "[A] claim sets forth a series of elements, each element or step of the claim should be separated by a line indentation."

"Elements" have been a part of claims since at least 1862 and continued to be so until the *Festo* case changed the nomenclature *en banc* and brought into sharp focus the question of which claim terms are subjected to PHE.[39] Although the courts and Congress have used different terms to refer to terms in a claim, the Federal Circuit's pronouncement in *Festo* has only further muddied the proverbial patent waters. Against the backdrop of *Festo's* complete bar rule against the doctrine of equivalents, a change in nomenclature only further complicates the analysis of whether and to what extent PHE bars the application of the doctrine of equivalents to a particular term.

[37] *See Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 933-35 (1987).

[38] *Sexant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 826 (Fed. Cir. 1999) (emphasis added); *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 149 F.3d 1309, n.*9. (Fed. Cir. 1998) ("we have stated that 'the All Elements rule might better be called the All Limitations rule. It will be referred to as such throughout the remainder of this opinion'").

[39] *Vance v. Campbell*, 66 U.S. (1 Black) 427, 429 (1862). There is one previous case that mentioned that claim terms were only limitations, but the *Festo* decision was *en banc*. *See Dawn Equip. Co. v. Kentucky Farms Inc.*, 140 F.3d 1009, 1014 n.1 (Fed. Cir. 1998).

5. PHE Applies To What and Why

When determining the scope and extent of PHE, as it applies to amended claim terms, there are two options. PHE can apply to either the claim term that has been amended or, alternatively, to the claim term that has been amended as well as some scope of related claim terms.[40] If PHE is found to apply to only the claim term that has been amended, the doctrine of equivalents will continue to have a viable role in patent litigation, as evidenced by the *ACLARA* case.[41] On the other hand, if PHE is applied to the amended claim term and all related terms under the complete bar of *Festo*, as in the *Lockheed* case, the doctrine of equivalents will likely cease to exist as a means to thwart the "unscrupulous copyist."[42] The convoluted, historical descriptions of "element" and "limitation" only serve to further exacerbate this problem that difficulty. For this reason, we ask the Court to clarify the scope and extent of the applicability of PHE to patent claim terms and provide meaningful definitions as to what elements and limitations are.

[40] If PHE is found to apply to a claim term that has been amended and a related claim term, then the amended term is likely a limitation and the related claim term is likely an element. If, on the other hand, PHE is limited to only the amended claim term, the amended claim term is likely an element.

[41] *ACLARA*, 125 F. Supp. 2d 391 (N.D. Cal. 2000).

[42] *Lockheed*, 249 F.3d 1314 (Fed. Cir. 2001); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 329 U.S. 605, 607-08 (1950).

6. Conclusion

The Patent, Trademark, & Copyright Section of the Bar Association of D.C. respectfully submits that an opinion that comments on which claim terms will be affected by prosecution history estoppel would prevent litigants and judges from spending valuable resources and time on tedious, difficult, time-consuming, and expensive claim term analysis that produces an uncertain result due to a lack of guidance. Evidence of this already exists with the aforementioned post-*Festo* cases of *Lockheed, ACLARA,* and *Creo* cases.[43]

[43] *Lockheed Martin Corp. v. Space Systems/Loral Inc.*, 249 F.3d 1314 (Fed. Cir. 2001); *ACLARA Biosciences, Inc. v. Caliper Technologies Corp.*, 125 F. Supp. 2d 391 (N.D. Cal. 2000); *Creo Products Inc. v. Presstek, Inc.*, 2001 WL 637397 (D. Del. 2001).

Respectfully submitted,

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OF THE
BAR ASSOCIATION OF THE
DISTRICT OF COLUMBIA
William P. Atkins
Counsel of Record
Pillsbury Winthrop, LLP
1600 Tysons Boulevard
McLean, Virginia 22102

Counsel for *Amicus Curiae*
Patent, Trademark, & Copyright
Section of the Bar Association
of the District of Columbia